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J. Georg Seka
Townsend and Townsend and Crew LLP
Two Embarcadero Center, 8th Floor
San Francisco, CA 94111

In re Application of	:	
Klockseth et al.	:	DECISION ON
Application No. 09/367666	:	
PCT No.: PCT/AU98/00099	:	PETITION UNDER
Int. Filing Date: 18 February 1998	:	
Priority Date: 18 February 1997	:	37 CFR 1.47(a)
For: Pressure Compensating Valve	:	

This is a decision on the renewed petition under 37 CFR § 1.47(a) filed on 30 May 2000.

BACKGROUND

This international application was filed on 18 February 1998, claiming priority of an earlier application filed on 18 February 1997. A Demand electing the United States was filed on 10 September 1998, which was prior to the elapse of 19 months from the priority date. The International Bureau transmitted a copy of the published international application to the United States Patent and Trademark Office on 27 August 1998. Accordingly, the 30 month time period for paying the basic national fee in the United States expired as of midnight on 18 August 1999.

On 17 August 1999, applicants filed a Transmittal Letter for entry into the national stage in the United States. The Transmittal Letter was not accompanied by, *inter alia*, the required basic national fee and an unsigned declaration of the inventors.

On 03 November 1999, a Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US) (Form PCT/DO/EO/905) was transmitted to applicant, indicating *inter alia* that "the current oath or declaration does not comply with 37 CFR 1.497(a) and (b) for the reasons indicated on the attached PCT/DO/EO/917." The Notification of Missing Requirements further required the submission of a surcharge under 37 CFR 1.492(e). Indicating that A Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917) was transmitted therewith, indicating that the "oath or declaration does not comply with 37 CFR 1.497(a) and (b)

in that it is not executed in accordance with 37 CFR 1.66 or 37 CFR 1.68."

On 06 March 2000, applicants filed the instant petition under 37 CFR 1.47(a), along with, *inter alia*, a petition and fee authorization for a three month extension of time under 37 CFR 1.136(a) and a declaration signed by inventor Goran Bertil Claes Berndtsson.

On 31 March 2000, a decision on petition was mailed to applicants. The petition was dismissed on the basis that applicants had not provided adequate evidence that non-signing inventors Mr. Jervmo and Mr. Klockseth "refuse to join" in the application or "cannot be found or reached after diligent effort" within the meaning of 37 CFR 1.47(a).

Applicants filed the instant renewed petition on 30 May 2000.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Petitioner has satisfied requirements (1), (3) and (4).

With respect to requirement (2), the renewed petition includes a document signed by joint inventor Mr. Berndtsson. Mr. Berndtsson attests that he has first-hand knowledge that Mr. Jervmo did not respond to "the necessary formal papers" being forwarded to his last known address on 30 August 1999. However, Mr. Berndtsson does not affirmatively state that the papers he refers to as the "necessary formal papers" include a complete copy of the application and a declaration of the inventors. Without such an affirmative statement, it cannot be concluded from the present record that Mr. Jervmo refused to sign the declaration within the meaning of 37 CFR 1.47. Moreover, Mr. Berndtsson's statement that he has made "several attempts to contact Bengt Jervmo and Oliver Klockseth and obtain the required signatures but have been unsuccessful" does not indicate the particulars of any of the attempted contacts, nor does it indicate whether (1) the inventor(s) could not be reached, or (2) the inventor(s) were reached but refused to sign.

Mr. Berndtsson also notes that "Mr. Klockseth was contacted by telephone and was verbally reluctant to sign the required formal papers." This statement does not clearly indicate that Mr. Klockseth *expressly refused* to sign the *declaration*; instead, it

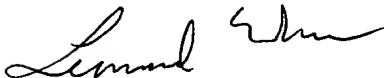
may be that the papers referred to as the "required formal papers" do not include the declaration. Also, Mr. Berndtsson does not identify the time of the telephone call(s). See MPEP 409.03(d). Mr. Berndtsson also indicates that papers were forwarded to Mr. Klockseth's "last known business address," but does not indicate what efforts if any were undertaken to send a copy of the declaration and application to Mr. Klockseth's last known *residential* address. In view of the deficiencies identified above, it would be inappropriate to grant the requested relief on the basis of the evidence currently of record.

DECISION

For the reasons explained *supra*, the petition is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



Leonard Smith
PCT Legal Examiner
PCT Legal Office



George M. Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6721
Fax: (703) 308-6459